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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046185
Party	Defendant PRO FOOTBALL, INC. PRO FOOTBALL, INC. 21300 Redskin Park Drive Ashburn, VA 22011
Correspondence Address	PRO FOOTBALL, INC. 21300 Redskin Park Drive Ashburn, VA 20147
Submission	Motion to Suspend for Civil Action
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Date	09/26/2006
Attachments	Blackhorse Motion to Suspend.pdf (55 pages)(1043029 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Registration No. 1,606,810 (REDSKINETTES)
Registered: July 17, 1990

In the matter of Registration No. 1,085,092 (REDSKINS)
Registered: February 7, 1978

In the matter of Registration No. 987,127 (THE REDSKINS & Design)
Registered: June 25, 1974

In the matter of Registration No. 986,668 (WASHINGTON REDSKINS & Design)
Registered: June 18, 1974

In the matter of Registration No. 978,824 (WASHINGTON REDSKINS)
Registered: February 12, 1974

In the matter of Registration No. 836,122 (THE REDSKINS - Stylized Letters)
Registered: September 26, 1967

AMANDA BLACKHORSE,
MARCUS BRIGGS,
PHILLIP GOVER,
SHQUANEBIN LONE-BENTLEY,
JILLIAN PAPPAN, AND
COURTNEY TSOTIGH

Cancellation No. 92/046,185

Petitioners,

v.

PRO-FOOTBALL, INC.

Registrant.

_____/

MOTION TO SUSPEND THE PROCEEDINGS

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), Registrant Pro-Football, Inc. ("Registrant") hereby requests that the Trademark Trial and Appeal Board (the "T.T.A.B."

or the "Board") suspend this cancellation proceeding until the final determination of *Pro-Football, Inc. v. Harjo* (Civil Action No. 99-1385 (CKK)), because the *Harjo* case will have a direct bearing on the instant proceeding, as Petitioners themselves acknowledge. (Petition for Cancellation at 3.)

FACTUAL BACKGROUND: THE *HARJO* PROCEEDING

In September 1992, Suzan Shown Harjo and six other Native Americans (collectively, the "*Harjo* Petitioners") petitioned the Board to cancel the six registrations at issue in the instant proceeding on the ground that use of the term "Redskin(s)" is scandalous, may disparage Native Americans, and may cast Native Americans into contempt or disrepute in violation of Section 2(a) of the Lanham Act. In its defense, Registrant asserted, *inter alia*, that its trademarks do not and will not disparage Native Americans; that its trademarks do not and will not bring Native Americans into contempt or disrepute; that the *Harjo* Petitioners' claims were barred by laches; and that Section 2(a), on its face and as applied, violates the First and Fifth Amendments of the Constitution of the United States. Following the Board's issuance of a cancellation order (issued on April 2, 1999), Registrant filed a Complaint with the District Court of the District of Columbia ("D.C.") seeking a *de novo* review of the Board's cancellation order, pursuant to 15 U.S.C. § 1071(b). *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003). The pleadings for that action are annexed hereto as Exhibit A.

Upon reviewing the factual and legal findings of the Board, the Court concluded that "the TTAB's finding that the marks at issue 'may disparage' Native Americans is unsupported by substantial evidence, is logically flawed, and fails to apply the correct legal standard to its own findings of facts." *Id.* at 125-26. The Court observed that "[n]one of the findings of fact made by the TTAB tend to prove or disprove that the marks at issue 'may

disparage' Native Americans, during the relevant time frame,[1] especially when used in the context of Pro-Football's entertainment services." *Id.* at 127. After a full review of the record--which included dictionary evidence, historical evidence, survey evidence, and evidence on media and fan use--the District Court concluded that the Board's determination that Registrant's marks may disparage Native Americans was not supported by substantial evidence.

On the issue of laches, reversing the T.T.A.B., the Court first ruled that laches is an available defense to a Respondent in a cancellation action under the Lanham Act. The Court then concluded that the *Harjo* Petitioners' delay in bringing the suit was substantial; that the *Harjo* Petitioners had both constructive and actual notice of the trademarks as of the dates of publication; and that Registrant would suffer economic prejudice from cancellation at this point in time. *Id.* at 139-44. In evaluating the prejudice to Registrant, the Court considered the significant marketing and advertising costs expended by Registrant over the years in the development of its brand.

On appeal, the D.C. Circuit remanded the issue of laches with respect to one *Harjo* Petitioner, Mateo Romero ("Romero"), who was only one year old in 1967 and thus eight years past majority when *Harjo* was instituted, and held that the District Court must consider Romero's laches from the date of his reaching majority. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. 2005). This laches review is pending, and the Court of Appeals has not yet ruled on the merits of the disparagement claim.

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[1] Petitioners have the burden of proving that the term "redskins" was disparaging on the date it was first registered on September 26, 1967.

ARGUMENT

I. The Determinations in *Harjo* Will Have A Direct Bearing On The Issues Before The Board

Where a party to a case pending before the Board is also involved in a civil action that may have a bearing on the T.T.A.B. matter, the Board may suspend the proceeding until the final determination of the civil action. 37 CFR § 2.117(a); TBMP § 510.02(a). This is because "a decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent's right to retain its registration would not be binding or res judicata in respect to the proceeding before the federal district court." *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971). A court's decision regarding both laches and the right to registration are binding on the T.T.A.B. *The Seven-Up Co. v. Bubble Up Co.*, 136 U.S.P.Q. 210, 214 (C.C.P.A. 1963); *see also In re Alfred Dunhill Ltd.*, 224 U.S.P.Q. 501, 503 (T.T.A.B. 1984); J. Thomas McCarthy, 4 *McCarthy on Trademarks and Unfair Competition* § 32:94 (4th ed. 2006) (hereinafter "McCarthy").

Registrant is a party to an action pending before the D.C. District Court involving the same trademarks, same alleged grounds for cancellation, and same defenses. *See* Exhibit A. Petitioners do not dispute that virtually identical issues exist in the two actions, and, indeed, here have explicitly professed their intention to rely on the record in *Harjo*: "Because Petitioners in this action are bringing a claim that is very similar to the one that was before the Board in the *Harjo* case, they plan to rely on a significant portion of the evidence present in the *Harjo* record for proving their case." (Petition for Cancellation at 3.)

The Court of Appeals' findings with respect to the sufficiency of the evidence presented in *Harjo* will bear directly on the Board's findings in the instant proceeding, as

Petitioners have indicated that they will be using a "significant portion" of that evidence. The Appellate Court's final conclusions as to whether this evidence suffices to establish that the matter contained in Registrant's marks is disparaging--the identical issue to that raised here--will be binding on the Board.

The Court of Customs and Patent Appeals has held that a laches ruling in a cancellation action applies with full force to later cancellation actions that raise the same facts on the laches issue. *The Seven-Up Co.*, 136 U.S.P.Q. at 214. "Where . . . one party to a cancellation proceeding has prevailed in a litigated and finally determined action by reason of the affirmative defense of laches *with respect to the same factual averments* which have been pleaded verbatim in a later cancellation proceeding, . . . it is incumbent on the Patent Office . . . to give effect to such an established defense . . . ." *Id.* (emphasis in original). Thus, if the District Court rules that the economic prejudice incurred by Registrant was of sufficient magnitude to support Registrant's laches defense, the T.T.A.B. must "give effect" to that ruling in the instant action. Such consideration is especially potent here, where Petitioners will most likely be relying on much of the same evidence as in *Harjo* to refute the economic-prejudice aspect of Registrant's laches defense. (*See* Petition for Cancellation at 3.)

Accordingly, the Court of Appeals' and the District Court's findings as to whether the evidence on the *Harjo* record is sufficient to establish that Registrant's marks are disparaging and as to the weight to be afforded Registrant's economic prejudice in the laches equation may impact directly the issues before the Board here. As the civil action thus may have a bearing on the instant matter, suspension is proper. 37 CFR § 2.117(a); TBMP § 510.02(a)

Based on the foregoing, Registrant respectfully requests that the Board stay this proceeding pending the final determination of *Harjo*.

Dated: New York, New York
September 26, 2006

Quinn Emanuel Urquhart Oliver & Hedges, LLP

By: _____

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EXHIBIT A

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

PRO-FOOTBALL, INC.
21300 Redskin Park Drive
Ashburn, Virginia 20147,

Plaintiff,

v.

SUZAN SHOWN HARJO
403 10th Street, SE
Washington, DC 20003,

RAYMOND D. APODACA
711 D Street, SE
Washington, DC 20003,

VINE DELORIA, JR.
3170 Howell Road
Golden, Colorado 80401,

NORBERT S. HILL, JR.
2817 LeGrange Circle
Boulder, Colorado 80303,

MATEO ROMERO
P.O. Box 1494
San Juan Pueblo, New Mexico 87566,

WILLIAM A. MEANS
3241 17th Avenue South
Minneapolis, Minnesota 55407,

MANLEY A. BEGAY, JR.
54 Rice Street
Cambridge, Massachusetts 02140,

Defendants.

CASE NUMBER 1:99CV01385
JUDGE: Colleen Kollar-Kotelly
DECK TYPE: Civil General
DATE STAMP: 06/01/99

Civil Action No.

COMPLAINT

Plaintiff Pro-Football, Inc. ("Pro-Football", "Washington Redskins", "Redskins" or "the Club"), by its attorneys White & Case LLP, for its complaint alleges as follows:

NATURE OF THE ACTION

1. Plaintiff Washington Redskins is one of the most storied sports franchises in the United States. It has, for more than six decades, continuously used the famous name "Redskins", and has held federal trademark registrations for as long as thirty years. This action seeks de novo review, pursuant to 15 U.S.C. § 1071(b), of an unprecedented administrative decision by the Trademark Trial and Appeal Board of the United States Patent and Trademark Office ("TTAB" or "Board") in a trademark cancellation proceeding brought by seven Native Americans entitled Harjo, et al. v. Pro-Football, Inc, Cancellation No. 21,069. By Order dated April 2, 1999 ("TTAB Order"), the TTAB scheduled the cancellation of the Redskins' federal registrations for trademarks containing the word "Redskins" (the "Redskins Marks"). The TTAB action was based on a sparingly used statutory provision, Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), which has never been used to cancel such long-held, valuable registrations as the Redskins Marks. The TTAB found that, as of the registration date for each of the trademarks at issue (1967, three in 1974, 1978, 1985 and 1990), use of the term "Redskins" "may be disparaging of Native Americans to a substantial composite of this group of people," and "may bring Native Americans into contempt or disrepute." As detailed below, the TTAB erred in numerous respects in taking this extraordinary action, which deprives the Redskins of their long-held, extremely valuable rights in its federal registrations for the Redskins Marks.

2. This case also raises serious constitutional issues not addressed by the TTAB. Trademarks such as the Redskins Marks are extraordinarily powerful and valuable communicators of information, embodying in a single word or two-word phrase the entirety of the Redskins' long history and rich tradition in the arena of professional football. The TTAB's action penalizes the Redskins for communicating to the public based on their marks' content. Moreover, Section 2(a)

of the Lanham Act, the statute relied upon by the TTAB for the cancellation of the Redskins' federal trademark registrations, is overly vague, deprives the Redskins of due process, and effectively chills constitutionally protected speech. The Board's actions, therefore, amount to governmental action in violation of the Redskins' First and Fifth Amendment rights.

3. Plaintiff Redskins seeks an Order of this Court: (1) reversing the TTAB Order scheduling the cancellation of the Redskins Marks; (2) declaring that the word "Redskins" or derivations thereof contained in the Redskins Marks, as identifiers of the professional football team, do not consist of or comprise matter that may disparage Native Americans; (3) declaring that the word "Redskins" or derivations thereof contained in the Redskins Marks, as identifiers of the professional football team, do not consist of or comprise matter that may bring Native Americans into contempt or disrepute; (4) declaring that Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), is unconstitutional, both on its face and as applied to the Redskins by the TTAB; (5) declaring that Defendants' petition for cancellation in the TTAB challenging the Redskins Marks under Section 2(a) was barred at the time it was brought by the doctrine of laches.

PARTIES

4. Plaintiff Pro-Football, Inc. owns and operates the Washington Redskins football club, one of the thirty-one (31) National Football League ("NFL") member clubs (the "Member Clubs") whose teams play professional football games. Plaintiff is a Maryland corporation with its principal place of business at 21300 Redskin Park Drive, Ashburn, Virginia.

5. Upon information and belief, Defendant Suzan Shown Harjo resides at 403 10th Street, SE, Washington, D.C.

6. Upon information and belief, Defendant Raymond D. Apodaca resides at 711 D Street, SE, Washington D.C.

7. Upon information and belief, Defendant Norbert S. Hill, Jr. resides at 2817 LeGrange Circle, Boulder, Colorado.

8. Upon information and belief, Defendant Vine Deloria, Jr. resides at 3170 Howell Road, Golden, Colorado.

9. Upon information and belief, Defendant Mateo Romero resides at San Juan Pueblo, New Mexico.

10. Upon information and belief, Defendant William A. Means resides at 3241 17th Avenue South, Minneapolis Minnesota.

11. Upon information and belief, Defendant Manley A. Begay resides at 54 Rice Street, Cambridge, Massachusetts.

JURISDICTION AND VENUE

12. This Court has subject matter jurisdiction pursuant to sections 15 U.S.C. § 1071(b)(1) and (4), which provide that a party dissatisfied with a final decision of the TTAB may institute a new civil proceeding challenging such decision. 15 U.S.C. § 1071(b)(4) provides that venue is proper in this district, where, as here, Defendants reside in a multiplicity of districts. This Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1331, and declaratory judgment jurisdiction pursuant to 28 U.S.C. § 2201.

PROCEDURAL BACKGROUND

13. In September 1992, Defendants petitioned the TTAB to cancel the registrations of the Redskins Marks. The basis for the Petition was Defendants' claim that the Redskins Marks

are scandalous, may disparage Native Americans and may bring Native Americans into contempt or disrepute in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

14. The registrations of the Redskins Marks that Defendants sought to cancel cover entertainment services in the form of the performance of professional football games, which are seen and followed by millions of football fans. The Redskins Marks at issue all contain the word "Redskins" or a derivation thereof:

- THE REDSKINS, stylized, registration No. 836,122, issued September 26, 1967;
- WASHINGTON REDSKINS, registration No. 978, 824, issued February 12, 1974;
- THE WASHINGTON REDSKINS & DESIGN, registration No. 986,668, issued June 18, 1974;
- THE REDSKINS & DESIGN, registration No. 987,127, issued June 25, 1974;
- REDSKINS, registration No. 1,085,092, issued February 7, 1978; and
- REDSKINETTES, registration No. 1,606,810, issued July 17, 1990.

(Copies of the registrations are attached hereto.)

Defendants also sought cancellation of Registration No. 1,343,442 for the mark SKINS issued June 18, 1985; however, the Board found that no cancellation proceeding had ever been instituted as to that mark, because it had been voluntarily canceled under an unrelated provision of the Lanham Act.

15. The Redskins denied all of the allegations contained in the Petition, and asserted eleven affirmative defenses, including, inter alia, defenses that granting the Petition would result in the violation of the Redskins' constitutional rights under the First and Fifth Amendments.

16. By interlocutory order, Harjo v. Pro Football, 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994) (hereinafter "Pretrial Order"), the TTAB, relying on its status as an administrative agency

and not an Article III court, decided that it was not empowered to entertain the Redskins' constitutional defenses. The TTAB, therefore, did not attempt to reconcile its decision or findings with the Constitution.

17. In its Pretrial Order, the TTAB also held that the relevant time frame for assessing whether the Redskins Marks violate Section 2(a) is the date of the issuance of each registration, as opposed to the filing date of the Petition in 1992. The Board also struck several of the affirmative defenses asserted by the Redskins, including the defense that the Petition was barred by the doctrine of laches because Defendants waited many years (even, as to some registrations, decades) to challenge these registrations.

18. Following several years of discovery and motion practice, and after submission of evidence and oral argument, on April 2, 1999, the TTAB scheduled the cancellation of the registrations for the Redskins Marks based on an improper finding that use of the term "Redskins" in the Redskins Marks "may be disparaging of Native Americans to a substantial composite of this group of people," and "may bring Native Americans into contempt or disrepute."

19. The TTAB properly found that none of the Redskins Marks "consist[s] of or comprise[s] scandalous matter." The TTAB also properly found that none of the symbols contained in the Redskins Marks, which include an Indian head profile and a spear and which appear in Registration Nos. 987,127 and 21,069, are scandalous, disparaging or bring Native Americans into contempt or disrepute.

HISTORY AND FAME OF THE VALUABLE WASHINGTON REDSKINS MARKS

20. The name Washington Redskins was adopted by the NFL franchise operating in the nation's capitol over sixty years ago, and is among the oldest of team names in any

professional sports league. In 1933, George Preston Marshall purchased the NFL franchise now named the Redskins. The team, then located in Boston and called the "Braves," moved from Braves Field to Fenway Park and was renamed "The Redskins" by Marshall to distinguish it from the professional baseball team playing in Boston. At the time the name "Redskins" was chosen for the team, William "Lone Star" Dietz, a Sioux Indian, was the team's coach. Since 1933, the Club has been known as the Washington Redskins or Redskins, and has built tremendous recognition in the Redskins Marks.

21. The Redskins have been leaders in the entertainment of the public through professional football games, broadcast via television and radio nationwide to millions of fans. They have appeared in five SUPER BOWL championship games, and won three of them, all since 1982.

22. The history and fame of the Redskins and the fame of the Redskins Marks, which were completely ignored by the TTAB in its Order, is perhaps best demonstrated by the level of interest in the Redskins expressed by members of the public nationwide. On any given Sunday during football season, many D.C. metropolitan area residents unite for several hours in following the Redskins' game. Throughout the country, Redskins fans follow the team through newspaper sports pages, electronic media, local and national television and radio broadcasts of Redskins games and, increasingly, broadcasts delivered via NFL satellite packages, which allow participating households to view games not televised nationally. Corporate sponsors vie to associate their companies and products with the Redskins Marks, and merchandise bearing the Redskins Marks is widely sold, purchased and recognized.

23. The history of the Redskins' success and contribution to the community and the public at large is not limited to football-related activities. Redskins' owners, players, coaches and

other personnel have been involved in civic and charitable activities in the Washington, D.C. community and the nation at large. The Club's national renown is also demonstrated by the historical and continuing recognition of the Club and attendance at games and team events by prominent political leaders.

24. The Redskins Marks are inherently valuable communicative symbols through which the public identifies the team and its players, both past and present, and the Club's storied history. The Redskins Marks do not merely identify the current team, but incorporate and communicate the entirety of the team's history and fame.

THE VALUABLE BENEFITS OF FEDERAL REGISTRATION OF THE REDSKINS MARKS

25. Plaintiff's federal trademark registrations confer valuable substantive and procedural rights and substantial government benefits, including but not limited to those described below.

26. A registration, as evidence of the trademark owner's constructive use of its mark, confers nationwide priority – from the filing date of the registration – on a registrant, as against any third party claiming first use of identical or similar marks.

27. A certificate of registration of a mark on the principal trademark register is prima facie evidence of the validity of the registered mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce or in connection with the goods or services specified in the certificate.

28. Because the Redskins Marks have been federally registered for well over five years, the marks are "incontestable" as that term is defined in Section 15 of the Lanham Act, 15 U.S.C. § 1065. To the extent the right to use a registered mark has become incontestable under

Section 15, the registration is conclusive evidence of the validity of the registered mark and of registration of the registered mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce.

29. In a federal trademark infringement action, the owner of a registered trademark may be entitled to treble profits and damages and attorney's fees, if successful against the defendant infringer.

30. The owner of a federally registered trademark, upon ex parte application, may be granted a court order authorizing the seizure of counterfeit goods and an award of treble profits and damages or statutory damages, as well as attorney's fees.

31. Under the federal anti-dilution statute, registration affords several significant, tangible benefits to owners of distinctive and famous marks such as the Redskins Marks. First, a trademark owner cannot obtain monetary relief under federal anti-dilution law without a registration. By contrast, a registrant who prevails on a dilution claim can recover treble profits and damages and attorney's fees. Second, the existence of a registration is a factor to be considered in determining whether a mark is distinctive and famous – the threshold inquiry for dilution. Federal registration therefore helps trademark owners prove a mark's strength so as to sustain an anti-dilution claim. Third, ownership of a federal registration immunizes the registrant from suit under state anti-dilution law.

32. A federal trademark registration gives the registrant the right to use the symbol "®", which affords notice to the public that the designation is being used as a trademark and thus permits the registrant, in any suit for infringement, to collect profits and damages without proof of actual notice.

33. No article of imported merchandise that copies or simulates a registered trademark without authorization of the trademark owner may be admitted into the United States by the United States Customs Service. In order to aid the Customs Service in enforcing this regulation, trademark registrants may record their trademark registration certificates with the Customs Service, pursuant to 15 U.S.C. § 1124.

34. The owner of a federal trademark registration may invoke the dispute policy of Network Solutions, Inc. in order to prevent the adoption and use of unauthorized and infringing Internet domain names.

35. The TTAB's scheduled cancellation of the Redskins Marks would deprive Plaintiff of the valuable benefits it has enjoyed for decades as a federal trademark registrant.

SECTION 2(a) OF THE LANHAM ACT

36. Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), provides, in relevant part, that no trademark shall be registered on the principal register that "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute".

37. As the TTAB explicitly acknowledged in its Order, assessing whether any mark, including the Redskins Marks, may be disparaging is a highly subjective determination, governed by guidelines that are at best "vague and indistinct".

38. Neither the Lanham Act nor its legislative history provides any guidance for defining the term "disparage" as used in Section 2(a).

39. The term "disparage" as used in Section 2(a) was explicitly acknowledged by the

Patent and Trademark Office and the legislators debating the enactment of this section of the Lanham Act to be a highly subjective term that would result in severe problems in its application. In the words of Leslie Frazier, Assistant Commissioner of Patents during the congressional hearings on Section 2(a): "the use of ['disparage'] in this connection is going to cause a great deal of difficulty in the Patent Office, because, as someone else has suggested, that is a very comprehensive word, and it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging."

40. Assessing whether any mark, including the Redskins Marks, may bring a group or individual into contempt or disrepute is a highly subjective determination, governed by guidelines that are at best "vague and indistinct".

41. Neither the Lanham Act nor its legislative history provides any guidance for defining the terms "contempt" or "disrepute" as used in Section 2(a).

42. The inclusion of the term "may" in conjunction with the words "disparage," "contempt" and "disrepute" adds to the vagueness of the terms.

ERRORS IN THE TTAB ORDER

The TTAB's Findings Regarding Disparagement and Contempt/Disrepute Constitute Errors of Law and are Based on Erroneous Findings of Fact

43. In its entire history, the TTAB has never canceled an incontestable mark that has been in use for more than six decades and validly registered without challenge for three decades based on the disparagement, contempt or disrepute provisions of Section 2(a) of the Lanham Act.

44. The TTAB's legal conclusions were in error, and are based on factual findings that are clearly erroneous, erroneous to a thorough conviction, and are otherwise insufficient to support cancellation under Section 2(a), even under a preponderance-of-the-evidence standard.

45. For example, the TTAB erred by relying on a survey that it admitted was severely flawed, particularly in the survey's inability to measure attitudes during the Board's stated relevant time period, e.g., when the marks were registered and issued to the Club. The Board acknowledged that the survey conducted by Defendants' expert was flawed, "of limited applicability" and "limit[ed] . . . probative value." Furthermore, the critical survey question failed to address the issue of "disparaging" in the context of professional football, but instead asked respondents for their views of the term "redskin" as referring to a person. Despite these fundamental flaws, which preclude a scientific or other credible basis for an expert report, the Board nevertheless received the report in evidence and relied on the defective data generated by the inadmissible survey.

46. The TTAB erred by concluding that the relevant group for assessing whether a mark is disparaging or contemptuous/disreputable is a substantial composite of Native Americans, and failing to define the term "substantial composite".

47. The TTAB was internally inconsistent by relying on evidence of the general public's perceptions of the term "Redskins", even though it had ruled that the viewpoint of Native Americans was the relevant perspective from which to assess the Redskins Marks under Section 2(a).

48. The TTAB erred by considering the actions of third parties – which the Board characterized as potentially disparaging or bringing Native Americans into contempt or disrepute – as evidence against the Club. The Board explicitly acknowledged that much of the Native American imagery that Defendants claim to be associated with Plaintiff is not used by Plaintiff, but by fans and the media, whose actions cannot be attributed to the Club. Indeed, the TTAB specifically found Plaintiff's use of Native American imagery in the significant period during the

1950's and early 1960's to be sensitive and tasteful. Nonetheless, the TTAB relied on the extraneous and nonprobative evidence of use by fans and the media in its assessment of the Redskins Marks.

49. The TTAB erred by relying on evidence outside the only time period that the Board itself determined was relevant. In its Pretrial Order, the Board held that the only time period relevant to the disparagement and contempt/disrepute questions was the date of issuance of Plaintiff's registrations (1967, 1974, 1978, 1985 and 1990). Nonetheless, the Board later improperly relied on a survey done in 1995 that cannot be used to ascertain public opinion in 1967 and the other dates of registration. Similarly, the Board erroneously relied on alleged historical and other evidence dating back to the 1600's in determining perceptions in 1967.

50. The TTAB erred by not giving consideration to the Club's intent in adopting and using the name since 1933. The Board failed to consider the evidence that the team name was adopted to honor Native Americans and that, indeed, the team's then-head coach was himself a Sioux Indian. The Board acknowledged the substantial evidence that, beginning in the 1960's, the Club's official literature and symbols were sensitive to Native Americans. The Board erred by not considering the Club's intent as a factor, despite testimony by experts retained by both Plaintiff and Defendants, supported by dictionary definitions, that the term "disparage" implicates the speaker's intent.

51. The Board erroneously concluded that the lack of evidence of general use of "redskins" from the 1960's forward indicates recognition by the general public that the use of the term "redskins" was "offensive" (although "offensive" is nowhere present in Section 2(a) and has a different meaning from the statutory language, specifically in not requiring a showing of intent). This erroneous conclusion improperly placed the burden of proving non-disparagement on the

Redskins.

52. The TTAB erred by holding in its Pretrial Order that Defendants' petition for cancellation was not barred by the doctrine of laches, despite the fact that Defendants waited in some cases decades to bring their claims.

53. As previously stated, the TTAB Order scheduling cancellation of Plaintiff's marks deprives Plaintiff of its famous, long-held federal trademark registrations without sufficient basis under the Lanham Act, against both the plain meaning and underlying intent of that statute. The Redskins Marks, as designations of the professional football team, do not disparage Native Americans or bring them into contempt or disrepute under any analysis of the terms "disparage", "contempt" or "disrepute". To the contrary, the name "Redskins", when used in association with professional football denotes only the team and connotes the history and tradition of the Club, embodying positive attributes, such as strength, sportsmanship and physical prowess, and evokes emotional reactions associated with the competition and entertainment provided by professional football.

The Board Declined to Consider Section 2(a)'s Constitutional Deficiencies

54. As previously stated, although Plaintiff explicitly raised their constitutional arguments at several stages of the proceedings (thereby preserving all such constitutional arguments for this action), the Board determined that it was not empowered to address Plaintiff's arguments as to the constitutionality of Section 2(a), but did note that the determination of "disparagement" is "highly subjective" and that there is a paucity of case law and legislative history to aid in interpreting the "disparaging" prong of Section 2(a). The Board also noted the dearth of case law and legislative history to assist in interpreting the meaning of "contempt" or "disrepute" in Section 2(a).

THE REDSKINS MARKS DO NOT DISPARAGE NATIVE AMERICANS

55. The Redskins Marks do not disparage Native Americans because, among other things, (1) the Redskins Marks as used by Plaintiff have developed a distinctive meaning in the context of professional sports that refers only to the football team in the Washington, D.C. area; (2) Native American persons support the team name and trademarks and use and employ the word "redskins" positively in other contexts; (3) Plaintiff had only positive intent in its adoption and use of the term "Redskins" as its team name and trademarks; and (4) the word "redskins" itself is not disparaging per se.

56. Defendants should be required to prove disparagement by clear and convincing evidence, because of the long-held property interest sought to be canceled and the constitutional issues at stake under the First and Fifth Amendments.

The Redskins Marks Do Not Disparage Native Americans When Viewed in the Context of Professional Sports, Where the Word "Redskins" Has Developed a Distinctive Meaning Referring to the Professional Football Team

57. A mark's registrability under Section 2(a) must be considered in the context of the mark's overall use in commerce.

58. A mark is not disparaging under Section 2(a) where the relationship between the mark and the goods or services used in connection with the mark is not in and of itself disparaging.

59. Plaintiff uses the term "Redskins" in the context of professional football.

60. Professional football games are neither of questionable morality nor per se offensive to or prohibited by Native American religious or cultural practices.

61. Professional football games enjoy nationwide recognition, including among Native Americans.

62. When used in connection with professional football games, the word "Redskins" bears only positive associations.

63. Neither Plaintiff nor any team member, as the TTAB explicitly found, has ever engaged in behavior perceived as disparaging Native Americans. Defendants conceded before the Board that they cannot point to even a single example of disparaging conduct by team players, coaches or team representatives.

64. Even if the term "redskin", used in singular, lower case form, refers to an ethnic group, the term is not disparaging when employed as a proper noun, as a team name, in the context of professional football.

65. The TTAB itself has recognized that the availability of an alternate meaning of a mark is important to the determination of whether the mark, as used, is disparaging.

66. As stated previously, through long, substantial and widespread use, advertising, promotion and media coverage nationwide over six decades, Plaintiff's Redskins Marks have acquired a strong and distinctive denotative meaning identifying the Club's entertainment services in the context of professional football.

67. As a result of this strong secondary meaning, "Redskins" was perceived in 1967, and today, to be a distinct denominative word, entirely separate from "redskin" as denoting ethnicity. Even though deriving from the original, ethnic meaning of "redskin", "Redskins" became, by 1967 at the latest, a separate, entirely positive term in context used solely to identify the professional Washington, D.C. area football team.

68. Today, three decades after its original registration, the use of "Redskins" as a denominative designation for the professional football team is even more deeply ingrained in

popular culture, and the distinctive meaning of "Redskins" even more firmly established in the English language.

69. By failing to consider the context of the use of "Redskins" as identifying the professional football team, the Board erred as a matter of law and was arbitrary and capricious.

The Public Uses "Redskins" to Identify and Associate With the Club

70. "Redskins" has been used extensively by the public to identify the professional football team from Washington D.C.

71. Year after year, merchandise bearing the Redskins Marks has been purchased by consumers in large quantities, indicating that many members of the consuming public desire to associate themselves with the Washington Redskins by purchasing and wearing or using products bearing the Redskins Marks.

72. Newspapers feature the team name "Redskins" in headlines and throughout sports articles and have continued to do so solely as a term of reference for the professional football team, not for persons of Native American descent. As noted supra, corporate sponsors actively associate themselves each year with the Redskins brand. Similarly, United States Presidents and Vice-Presidents have openly and publicly associated themselves with the Washington Redskins.

There is Native American Support for the Team Name and Term "Redskins"

73. The TTAB has recognized the value, to the ultimate determination of whether the challenged mark violates Section 2(a), of factual evidence comprising reactions of persons in the allegedly disparaged group.

74. Native Americans recognize the goodwill and positive attributes that accompany the team name "Redskins" and advocate retention of the "Redskins" name and support the team.

75. Defendants have conceded that they speak only for themselves and not on behalf of or with the support of any tribe. The 1995 Federal Register of recognized American Indian tribal entities reveals that there are over five hundred official tribes throughout the United States.

76. The TTAB failed to consider clear evidence that there are Native Americans, including tribal chiefs and recognized leaders, who react positively to "Redskins" as used to denote the professional football team from Washington, D.C.

77. The TTAB ignored evidence from Native American reservations showing that the word "redskin", even when used in other contexts, is not disparaging.

The Club's Positive Intent in the Selection and Usage of the Team Name Precludes Disparagement Under Section 2(a)

78. The TTAB erroneously declined to consider the Club's positive intent in its use and selection of the team name "Redskins", despite testimony by experts retained by both sides that the word "disparage" requires intent on the part of the speaker.

79. Disparagement has been defined as the utterance of a statement that the speaker intends to be understood as demeaning, deprecatory or belittling. The focus thus is on the intent of the speaker. This focus on the speaker's intent is required by the First Amendment, which considers whether the speech itself is protected, regardless of the subjective feelings of listeners.

80. Section 2(a) of the Lanham Act does not include "offensive" in its specification of grounds for prohibiting registration. "Offensive" and "disparaging" have very different meanings. "Disparage" means "to speak of in a slighting way; belittle." "Offensive," in contrast, is defined as "disagreeable to the senses; causing anger, displeasure, resentment, or affront."

81. Plaintiff's intent in adopting the team name was entirely positive. As Plaintiff has publicly stated: "Over the long history of the Washington Redskins, the name has reflected

positive attributes of the Native American such as dedication, courage and pride." The Club has continuously represented Native Americans in a "reserved and tasteful" manner.

82. Respondent's respectful intent in both the adoption and usage of the team name is illustrated by tasteful and dignified traditional portraits of distinguished Native American tribal chiefs on game program covers in the 1950's and 1960's. Likewise, the Native American profile featured in the team logo is a respectful and serious cultural portrayal, and is similar to the Native American representation on the United States nickel. Respondent is thus no different from other organizations, including the United States government, that adopt positive, powerful namesakes and images.

The Word "Redskin" is not Disparaging Per Se

83. Even without considering the context of "Redskins" – which the Board was required but refused to do – the word "redskin" is not per se disparaging.

84. Dictionary evidence indicates that the word "redskin" in general is not disparaging. Editorial designations in the form of dictionary usage labels can be valuable indicators of contemporary perceptions of a particular word at a particular point in time. Dictionaries extant during the relevant time period as determined by the TTAB, 1967 and 1974, when Respondent's earlier registrations issued, typically do not contain any usage label for the word "redskin," thus indicating the term in general to be unremarkable and not disparaging. Moreover, the absence of negative editorial labels used with the term "redskin" demonstrates that the word was considered not disparaging and was used simply as a synonym for "Native American".

85. The TTAB failed to recognize the evidence in the record that literary and cinematographic uses of "redskin" as an ethnic denotator reflect usage of the term as a neutral term synonymous and interchangeable with "Native American" or "Indian."

THE REDSKINS MARKS DO NOT BRING NATIVE AMERICANS INTO CONTEMPT OR DISREPUTE

86. Defendants bear the burden of proving that the Redskins Marks as designations of the team may bring Native Americans into contempt or disrepute, under Section 2(a).

87. Defendants should be required to prove contempt or disrepute by clear and convincing evidence, because of the long-held property interest sought to be canceled and the constitutional issues at stake.

88. The TTAB's finding that the Redskins Marks "may bring Native Americans into contempt or disrepute" was based on the same evidence it considered to conclude that the Redskins Marks "may disparage" Native Americans.

89. The TTAB's failure to identify a separate meaning for the words "contempt or disrepute" and "disparage" is clearly erroneous because of the presumption that Congress intends to give precise, distinct meanings to the different words in a statute.

90. Because the TTAB's legal and factual conclusions were in error, and for the reasons set forth in the cited paragraphs, the Redskins Marks do not bring Native Americans into contempt or disrepute.

THE FIRST AND FIFTH AMENDMENTS WOULD BE VIOLATED BY ENFORCING SECTION 2(A) AGAINST RESPONDENT

91. The TTAB erroneously failed to consider the Constitution in construing Section 2(a) of the Lanham Act.

92. Trademarks are constitutionally protected commercial speech. A trademark communicates a virtually unlimited range of messages. In the complex commercial world that has developed this century, a trademark is a shortcut, a book reduced to a single word or phrase,

communicating the quality, value, producer, sponsor and limitless other attributes of a product or service.

93. The Redskins Marks, moreover, are deserving of even greater protection than pure commercial speech, which merely proposes a commercial transaction. Trademarks – particularly marks that have been so long-held and are as indisputably famous as the Redskins Marks – are core speech, representing virtually infinite expression through a mere symbol, phrase or individual word. Plaintiff and the general public use the Redskins Marks to invoke the history and storied success of the Club, and the marks evoke emotional responses from spectators and fans. Thus, the Redskins Marks consist of speech more akin to a film, novel or work of art than to a mere proposal to engage in a commercial transaction.

94. The provisions of Section 2(a) of the Lanham Act relied upon by the TTAB stand apart from the general regulatory scheme of the Act, which is designed generally to review, register, and then accord protection to designations functioning as trademarks. The disparagement and contempt/disrepute provisions of Section 2(a) do not test for basic trademark functionality. Indeed, it cannot be disputed that the Redskins Marks have the necessary attributes to function as trademarks and therefore qualify for federal trademark registration: they are famous marks that have been registered for up to thirty-two years and in which Plaintiff has worked to establish extremely valuable rights for over sixty years.

95. Rather, targeting the so-called "disparaging", "contempt[uous]" or "disreput[able]" aspects of a mark, Section 2(a) regulates the actual content of a mark's message.

96. Section 2(a) conditions the granting of the benefits of federal trademark registration upon the registrant not exercising constitutionally protected free speech rights. Such unconsitutional conditions are as offensive to the Constitution as a direct prohibition of speech.

The government may not withhold a benefit from the Club or anyone else on a basis that impinges upon the right of free speech.

97. Section 2(a) is an impermissible content-based restriction inherently violative of the First Amendment. The First Amendment prohibits all viewpoint discrimination, even that directed at suppressing racially offensive or debasing speech. The TTAB's cancellation of the Redskins Marks would deny Plaintiff the valuable benefits of federal registration based solely on the content of the protected speech contained in the Redskins Marks. Section 2(a) of the Lanham Act, both on its face and as applied to Plaintiff by the TTAB, is a classic unconstitutional restriction on speech in violation of the First Amendment.

98. The Constitution requires that speech that does not immediately affect conduct, such as fighting words, can only be regulated under the most stringent and narrowly defined circumstances, as in the case of defamation or obscenity.

99. The terms "disparage", "may disparage", "contempt", "disrepute", and "may bring ... into contempt or disrepute" – which the TTAB acknowledges are not defined in the statute or in its legislative history – are unconstitutionally vague. The statutory language of Section 2(a) conveys no ascertainable standards for trademark owners to follow and thereby leaves the Board with virtually unfettered discretion to deny registration or to cancel registrations, even in situations such as presented here, where for over sixty years Plaintiff has worked to establish valuable rights in its marks, and has owned its initial registration in the series of marks, for thirty years. Section 2(a) thus effectively chills First Amendment speech rights.

100. The terms "disparage", "may disparage", "contempt", "disrepute", and "may bring ... into contempt or disrepute" are unconstitutionally overbroad, allowing for the potential to

sweep under their rubrics speech that is essentially unremarkable in context and not capable of being legitimately regulated by the government as imminently harmful.

101. No governmental interest has been asserted to justify such severe, constitutionally offensive injury to Plaintiff.

102. A federal trademark registration does not confer any government endorsement or imprimatur.

103. As applied to Plaintiff, Section 2(a) violates the First Amendment, because: (a) Plaintiff's trademarks constitute truthful, nonmisleading, lawful speech; (b) any asserted governmental interest in regulating the content of Plaintiff's registered trademarks is not substantial; (c) Plaintiff may continue to use its marks absent federal registrations, and because federal registration does not confer any official endorsement or imprimatur, any asserted state interests would not be advanced by cancellation, and thus Section 2(a) does not directly advance any such governmental interest; and (d) Section 2(a) is more extensive than necessary, in that it prohibits registration not just of obscene or fighting words, but of nonmisleading, lawful terms that communicate a message that some might perceive as offensive, while others might not.

104. Because Section 2(a) is unconstitutionally vague, it operates to deprive trademark owners, such as Plaintiff, of property without due process of law, in violation of the Fifth Amendment.

DEFENDANTS' LONG DELAY IN SEEKING RELIEF

105. The Redskins Marks have been registered for as long as thirty years and known to Defendants for most, if not all, of that time. Defendants can offer no valid reason for waiting many years, decades in some cases, between the date(s) on which they first learned of the

Redskins Marks and September 10, 1992, the date on which they filed the Petition for Cancellation at issue in this matter.

106. The Redskins have invested millions of dollars in the use, promotion, registration and protection of the Redskins Marks over the past sixty years, and, specifically, over the thirty years since the initial registration issued for the Redskins Marks. The substantial goodwill and value in the Redskins Marks developed by the Redskins through such effort and expense was done prior to any complaint or objection by Defendants.

107. Because of the tremendous value in the Redskins Marks developed by the Redskins over the better part of this century, the long period of Defendants' inexcusable delay in bringing their Petition for cancellation has resulted in extreme prejudice to the Redskins. Defendants, therefore, should have been barred from bringing their claims pursuant to the doctrine of laches.

FIRST CAUSE OF ACTION
(Declaration Of Non-Disparagement)

108. Plaintiff repeats and realleges the allegations of paragraphs 1 through 107 of the Complaint as if fully set forth herein.

109. Plaintiff's Redskins Marks do not, and will not, disparage Native Americans in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

SECOND CAUSE OF ACTION
(Declaration Of Non-Contempt or Disrepute)

110. Plaintiff repeats and realleges the allegations of paragraphs 1 through 107 of the Complaint as if fully set forth herein.

111. Plaintiff's Redskins Marks do not, and will not, bring Native Americans into contempt or disrepute in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

THIRD CAUSE OF ACTION
(Declaration that Section 2(a) of the Lanham Act Violates the First Amendment)

112. Plaintiff repeats and realleges the allegations of paragraphs 1 through 107 of the Complaint as if fully set forth herein.

113. Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), is a content-based, blanket restriction on speech that inherently violates the First Amendment to the United States Constitution.

114. Section 2(a) is facially overbroad, in violation of the First Amendment.

115. Section 2(a) is void for vagueness under the First Amendment.

116. As applied to Plaintiff, Section 2(a) violates the First Amendment.

FOURTH CAUSE OF ACTION
(Declaration that Section 2(a) of the Lanham Act Violates the Fifth Amendment)

117. Plaintiff repeats and realleges the allegations of paragraphs 1 through 107 of the Complaint as if fully set forth herein.

118. Because of its vagueness, Section 2(a) abridges Plaintiff's due process rights provided by the Fifth Amendment to the United States Constitution.

FIFTH CAUSE OF ACTION
(Declaration that Defendants' Petition Was Barred by the Doctrine of Laches)

119. Plaintiff repeats and realleges the allegations of paragraphs 1 though 107 of the Complaint as if fully set forth herein.

120. As a result of Defendants' inexcusable delay in filing the Petition for Cancellation of the Redskins Marks, and the undue prejudice suffered by Plaintiff, Defendants' Petition for Cancellation before the TTAB was barred by the doctrine of laches.

WHEREFORE, Plaintiff requests this Court to enter judgment:

(a) reversing the Order of the Trademark Trial and Appeal Board, dated April 2, 1999, scheduling cancellation of Plaintiff's Washington Redskins trademark registrations; and

(b) ordering the Trademark Trial and Appeal Board to deny Defendant's Petition for Cancellation; and

(c) declaring that Plaintiff's Redskins Marks do not disparage Native Americans, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a); and

(d) declaring that Plaintiff's Redskins Marks do not bring Native Americans into contempt or disrepute, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a); and

(e) declaring that Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on its face is unconstitutional under the First Amendment to the United States Constitution; and

(f) declaring that Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), as applied to Plaintiff is unconstitutional under the First Amendment to the United States Constitution; and

(g) declaring that Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), is unconstitutional under the Fifth Amendment to the United States Constitution; and

(h) ordering the Trademark Trial and Appeal Board to dismiss Defendants' petition for cancellation challenging the Redskins Marks under Section 2(a), because the petition was barred by the doctrine of laches at the time it was brought in the TTAB; and

(i) awarding Plaintiff such other and further relief as this Court may deem proper.

Dated: Washington, D.C.
June 1, 1999

Respectfully submitted,

WHITE & CASE LLP

By: 

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United States Patent Office

836,122
Registered Sept. 26, 1967

PRINCIPAL REGISTER
Service Mark

Ser. No. 258,227, filed July 14, 1966

The Redskins

Pro-Football, Inc. (Maryland corporation)
The Redskin Bldg., 9th St. at H NW.
Washington 1, D.C.

For: ENTERTAINMENT SERVICES—NAMELY, FOOTBALL EXHIBITIONS RENDERED LIVE IN STADIA AND THROUGH THE MEDIA OF RADIO AND TELEVISION BROADCASTS—in CLASS 107.
First use about 1932; in commerce about 1932.
Owner of Reg. No. 540,424.

J. BREEN, Examiner.

REGISTERED FOR A TERM OF 20 YEARS FROM Sept. 26, 1967

COMB. AFF. SEC 8 & 15

Attest

MAR 9 1983

Attesting Officer

Certified to be a true copy of the registration, which is in full force and effect, with notations of all effective actions taken thereon, excluding transfers, as disclosed by the records of the United States Patent & Trademark Office.

COMMISSIONER OF PATENTS

The United States of America

CERTIFICATE OF RENEWAL

Reg. No. 836,122

Application to renew the above identified registration having been duly filed in the Patent and Trademark Office and there having been compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

This is to certify that said registration has been renewed in accordance with the Trademark Act of 1946 to Pro-Football, Inc., of Herndon, Virginia, A Maryland Corporation

and said registration will remain in force for twenty years from September 26, 1987 unless sooner terminated as provided by law.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-sixth day of April, 1988.

Commissioner of Patents and Trademarks

United States Patent Office

978,824
Registered Feb. 12, 1974

PRINCIPAL REGISTER
Service Mark

Ser. No. 435,243, filed Sept. 11, 1972

WASHINGTON REDSKINS

Pro-Football, Inc. (Maryland corporation)
13832 Redskin Drive, Redskin Park, P.O. Box 17247
Washington, D.C. 20041

For: ENTERTAINMENT SERVICES—NAMELY, PRESENTATIONS OF PROFESSIONAL FOOTBALL CONTESTS—in CLASS 107 (INT. CL. 41).
First use Sept. 19, 1937; in commerce Sept. 19, 1937.
Owner of Reg. Nos. 836,121 and 836,122.

M. E. ABRAMSON, Supervisory Examiner

REGISTERED FOR A TERM OF 20 YEARS FROM Feb. 12, 1974

COMB. AFF. SEC 8 & 15

Attest

MAR 9 1983

Attesting Officer

Certified to be a true copy of the registration which is in full force and effect, with notation of all effective actions taken thereon, excluding transfers, as disclosed by the records of the United States Patent & Trademark Office.

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent Office

Reg. No. 986,668

Registered June 18, 1974

SERVICE MARK

Principal Register

REGISTERED FOR A TERM OF 20 YEARS FROM June 18, 1974

WASHINGTON

REDSKINS

Amd. Sec. 8 Accpt.

Pro-Football, Inc. (Maryland corporation)
13832 Redskin Drive
Redskin Park
P.O. Box 17247
Washington, D.C. 20041

For: ENTERTAINMENT SERVICES—NAMELY, PRESENTATIONS OF PROFESSIONAL FOOTBALL CONTESTS, in CLASS 107 (INT. CL. 41).
First use January 1941; in commerce January 1941.
Owner of Reg. Nos. 836,121 and 836,122.

Ser. No. 435,127, filed Sept. 11, 1972.

Certified to be a true copy of the registration, which is in full force and effect, with notations of all effective actions taken thereon, excluding transfers, as disclosed by the records of the United States Patent & Trademark Office.

Attest

MAR 9 1983

Attesting Officer

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent Office

Reg. No. 987,127

Registered June 25, 1974

SERVICE MARK

Principal Register

The Redskins

Pro-Football, Inc. (Maryland corporation)
13832 Redskin Drive, Redskin Park
P.O. Box 17247
Washington, D.C. 20041

For: ENTERTAINMENT SERVICES—NAMELY, PRESENTATIONS OF PROFESSIONAL FOOTBALL CONTESTS, in CLASS 107 (INT. CL. 41).
First use January 1941; in commerce January 1941.
Owner of Reg. Nos. 836,121 and 836,122.

Ser. No. 435,244, filed Sept. 11, 1972.

M. E. ABRAMSON, Supervisory Examiner

REGISTERED FOR A TERM OF 20 YEARS FROM June 25, 1974

COMB. AFF. SEC 8 & 15

Attest

MAR 9 1983

L. R. Hill
Attesting Officer

Certified to be a true copy of the registration which is in full force and effect, with notation of all effective actions taken thereon, excluding transfers, as disclosed by the records of the United States Patent & Trademark Office.

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 41

Prior U.S. Cl.: 107

Reg. No. 1,606,810

United States Patent and Trademark Office

Registered July 17, 1990

SERVICE MARK
PRINCIPAL REGISTER

REDSKINETTES

PRO FOOTBALL, INC. (MARYLAND CORPORATION)
REDSKIN PARK, P.O. BOX 17247 - DULLES
13832 REDSKIN DRIVE
WASHINGTON, DC 20041

FOR: ENTERTAINMENT SERVICES, NAMELY, CHEERLEADERS WHO PERFORM DANCE ROUTINES AT PROFESSIONAL FOOTBALL GAMES AND EXHIBITIONS AND OTHER PERSONAL APPEARANCES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 0-0-1962; IN COMMERCE 0-0-1962.

SER. NO. 73-829,272, FILED 10-4-1989.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

PRO-FOOTBALL, INC.,

Plaintiff

v.

SUZAN SHOWN HARJO, RAYMOND D. APODACA, VINE DELORIA JR., NORBERT S. HILL JR., MATEO ROMERO, WILLIAM A. MEANS, JR. AND MANLEY A. BEGAY JR.

Defendants

Case Number 1: 99CV01385
Judge: Colleen Kollar-Kotelly
Deck Type: Civil General

JOINT ANSWER TO COMPLAINT

Defendants Suzan Shown Harjo (Cheyenne & Arapaho Tribes of Oklahoma), Raymond D. Apodaca (Pueblo of Ysleta del Sur), Vine Deloria, Jr. (Standing Rock Sioux Tribe), Norbert S. Hill, Jr. (Oneida Tribe of Wisconsin), Mateo Romero (Cochiti Pueblo), Manley A. Begay, Jr. (Navajo Nation), and William A. Means, Jr. (Oglala Sioux Tribe of Pine Ridge) (collectively, "Native American Parties") are all Native American persons, and each is a member of a different federally-recognized Indian tribe. As and for their Answer to the Complaint of Pro-Football, Inc. ("plaintiff" or "Washington Football Club"), the Native American Parties jointly admit, deny, state, and allege as follows.

Prefatory Statement

In 1992, the Native American Parties commenced an action before the Trademark Trial and Appeal Board seeking cancellation of certain service marks owned by the Washington

Football Club and containing the term *redskin(s)*. The history of the treatment of Native Americans, the history of the pejorative word *redskins(s)*, and other abundant evidence clearly demonstrate that the term *redskin(s)*, on its face and in its derivative forms, is today and always has been a deeply offensive, humiliating, and degrading racial slur. Throughout their lifetimes, each one of the Native American Parties has directly experienced the disparagement, contempt, and disrepute inherent in the use of the term *redskin(s)*. The Trademark Trial and Appeal Board properly embraced a straightforward legal basis for cancellation of the challenged marks. Section 14(3) of the Lanham Act provides for cancellation of a registration "at any time," if the subject mark was registered "contrary to the provisions" of Section 2(a) of the Lanham Act. 15 U.S.C. § 1064(3) (1995). Pursuant to Section 2(a), no mark shall be registered if it consists of or comprises "matter which may disparage... persons,... or bring them into contempt, or disrepute...." 15 U.S.C. § 1052(a) (1995). Each of the challenged marks contains the racial slur *redskin(s)* and was properly ordered to be canceled under Section 2(a).

Response to Factual Allegations

For their responses to the specific allegations set forth in plaintiff's Complaint, the Native American Parties respond as follows.

1. Admit that the Washington Football Club is located in the United States and owns the trademark registrations at issue; admit that those marks have been scheduled for cancellation by the Trademark Trial and Appeal Board("TTAB") pursuant to Section 2(a) of the Lanham Act; state that the TTAB's Order speaks for itself; deny that the TTAB erred in any material respect; and otherwise deny paragraph 1 of plaintiff's Complaint.

2. Deny that Section 2(a) of the Lanham Act is unconstitutional, on its face or as applied, and deny that plaintiff has been denied due process.

3. Admit that plaintiff brings this action for the stated purposes.

4. Admit the allegations of paragraph 4 of plaintiff's Complaint.

5. Admit that Suzan Shown Harjo resides in Washington , D.C.

6. Admit that Raymond D. Apodaca resides in Washington, D.C.

7. Admit that Norbert S. Hill, Jr. resides in Boulder, Colorado.

8. Admit that Vine Deloria, Jr. resides in Golden, Colorado.

9. Admit that Mateo Romero resides in San Juan Pueblo, New Mexico.

10. Admit that William A. Means, Jr. resides in Minneapolis, Minnesota.

11. Admit that Manley A. Begay, Jr. resides in Cambridge, Massachusetts.

12. Admit that this Court has subject matter jurisdiction and that venue in this District is proper.

13. Admit the allegations of paragraph 13 of plaintiff's Complaint.

14. Admit the allegations of paragraph 14 of plaintiff's Complaint.

15. State that plaintiff's response to the petition before the TTAB speaks for itself.

16. State that the interlocutory order referenced in paragraph 16 of plaintiff's Complaint speaks for itself.

17. State that the Order referenced in paragraph 17 of plaintiff's Complaint speaks for itself.

18. Admit that the parties engaged in several years of discovery and motion practice and that the TTAB scheduled the cancellation of the registrations; deny that the TTAB finding

referenced in paragraph 18 of plaintiff's Complaint was improper; and state that the TTAB's Order speaks for itself.

19. State that the Order referenced in paragraph 19 of plaintiff's Complaint speaks for itself.

20. Admit that the Washington Football Club adopted the name "Redskins" more than 60 years ago; state that they are without knowledge or information sufficient to form a belief as to the age of other team names; admit that George Preston Marshall purchased the referenced NFL franchise, named it, and moved it to Washington; deny the statements as to his purpose in naming the team; and otherwise deny the last two sentences of paragraph 20 of plaintiff's Complaint.

21. State that the first sentence in paragraph 21 of plaintiff's Complaint is too vague to admit or deny; admit the second sentence.

22. Admit that some number of persons follow the Washington Football Club; admit that merchandise bearing the challenged marks is sold from time to time; and state that the remainder of paragraph 22 of plaintiff's Complaint is too vague to admit or deny.

23. State that they are without knowledge sufficient to form a belief as to the allegations in paragraph 23 of plaintiff's Complaint.

24. Admit that the challenged marks are communicative and affirmatively allege that the marks disparage Native Americans.

25. State that the provisions of the Lanham Act, 15 U.S.C. § 1051 et seq. set forth the benefits of federal trademark registrations.

26. State that the provisions of the Lanham Act, 15 U.S.C. § 1051 et seq. set forth the benefits of federal trademark registrations.

27. State that the provisions of the Lanham Act, 15 U.S.C. § 1051 et seq. set forth the benefits of federal trademark registrations.

28. State that the provisions of the Lanham Act, 15 U.S.C. § 1051 et seq. set forth the benefits and requirements of federal trademark registrations; deny that all of the marks had been registered for five years as of the time that the action before the TTAB was commenced; and affirmatively allege that the marks were not registrable in the first instance.

29. State that the provisions of the Lanham Act, 15 U.S.C. § 1051 et seq. set forth the benefits of federal trademark registrations.

30. State that the provisions of the Lanham Act, 15 U.S.C. § 1051 et seq. set forth the benefits of federal trademark registrations.

31. State that the provisions of the federal anti-dilution statute, 15 U.S.C. § 1125. speak for themselves.

32. Admits that the owner of a registered mark can use the symbol "®" and state that the Lanham Act provisions regarding its use speak for themselves.

33. State that the provisions of 15 U.S.C § 1124 speak for themselves.

34. State that the Network Solutions, Inc. dispute policies speak for themselves.

35. State that the allegations of paragraph 35 are too vague to admit or deny.

36. State that the provisions of 15 U.S.C § 1052(a) speak for themselves.

37. State that the Order referenced in paragraph 37 of plaintiff's Complaint speaks for itself.

38. State that the legislative history referenced in paragraph 38 of plaintiff's Complaint speaks for itself.

39. State that the legislative history referenced in paragraph 39 of plaintiff's Complaint speaks for itself; and affirmatively allege that the use of the term "disparage" has not resulted in "severe problems in its application."

40. Deny the allegations of paragraph 40 in plaintiff's Complaint.

41. State that the legislative history referenced in paragraph 41 of plaintiff's Complaint speaks for itself.

42. Deny the allegations of paragraph 41 in plaintiff's Complaint.

43. State that they are without knowledge r information sufficient to form a belief as to the truth of the allegations set forth in paragraph 43 of plaintiff's Complaint; and affirmatively state that the alleged infrequency in the invocation of Section 2(a) of the Lanham Act demonstrates that the statute does not result in "severe problems in its application."

44. Deny the allegations set forth in paragraph 44 of plaintiff's Complaint.

45. Deny the allegations set forth in paragraph 45 of plaintiff's Complaint, except state that the referenced Order speaks for itself.

46. Deny the allegations set forth in paragraph 46 of plaintiff's Complaint.

47. Deny the allegations set forth in paragraph 47 of plaintiff's Complaint.

48. Deny the allegations set forth in paragraph 48 of plaintiff's Complaint, except state that the referenced Order speaks for itself.

49. Deny the allegations set forth in paragraph 49 of plaintiff's Complaint, except state that the referenced Orders speak for themselves.

50. Deny the allegations set forth in paragraph 50 of plaintiff's Complaint, except state that the referenced Order speaks for itself.

51. Deny the allegations set forth in paragraph 51 of plaintiff's Complaint.

52. Deny the allegations set forth in paragraph 52 of plaintiff's Complaint, and affirmatively allege that the defense of laches is not available under Section 2(a) of the Lanham Act.

53. Deny the allegations set forth in paragraph 53 of plaintiff's Complaint.

54. Admit that plaintiff raised certain constitutional arguments and state that the Orders referenced in paragraph 54 of plaintiff's Complaint speak for themselves.

55. Deny the allegations set forth in paragraph 55 of plaintiff's Complaint; and affirmatively allege that the challenged marks disparage Native Americans and that the alleged subjective intent of plaintiff are legally irrelevant.

56. Deny the allegations set forth in paragraph 56 of plaintiff's Complaint, state that plaintiff cites no legal authority for its proposal to impose a higher standard of proof on defendants, and affirmatively allege that the Native American Parties have in any event satisfied that standard.

57. Deny the allegations set forth in paragraph 57 of plaintiff's Complaint.

58. Deny the allegations set forth in paragraph 58 of plaintiff's Complaint.

59. Admit that plaintiff uses the term "Redskins"; state that plaintiff's use of the term, by its own statements and imagery, refers directly to Native Americans; and otherwise deny the allegations set forth in paragraph 59 of plaintiff's Complaint.

60. Admit that the game of football is not itself of questionable morality, per se offensive, or prohibited by Native American religions; affirmatively allege that one or more of the Native American Parties have participated in organized football, that all have participated in sports, and that all have participated in tribal religious practices; and otherwise deny the allegations of paragraph 60 in plaintiff's Complaint.

61. State that the allegations of paragraph 61 in plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

62. Deny the allegations set forth in paragraph 62 of plaintiff's Complaint.

63. State that the TTAB Order referenced in paragraph 63 of plaintiff's Complaint and any statements made by Native American Parties' counsel at oral argument speak for themselves.

64. Deny the allegations set forth in paragraph 64 of plaintiff's Complaint.

65. State that the allegations of paragraph 65 in plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

66. Deny the allegations set forth in paragraph 66 of plaintiff's Complaint.

67. Deny the allegations set forth in paragraph 67 of plaintiff's Complaint.

68. Deny the allegations set forth in paragraph 68 of plaintiff's Complaint.

69. Deny the allegations set forth in paragraph 69 of plaintiff's Complaint.

70. Admit that the term "Redskins" has been used, from time to time, to refer to the Washington Football Club; state that plaintiff's use of the term refers explicitly to Native Americans; and otherwise deny the allegations of paragraph 70 of plaintiff's Complaint.

71. Admit that products containing one or more of the disparaging "Redskins" marks have, from time to time, been sold to consumers; state that the remaining allegations in paragraph 71 of plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

72. Admit that some but not all newspapers have continued to report on the activities of the Washington Football Club using the disparaging term that the Washington Football Club has selected for itself; state that the largest newspaper in the area of the Washington Football Club has editorialized for the name "Redskins" to be changed; and state that the remaining allegations in paragraph 72 of plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

73. State the TTAB Order reference in paragraph 73 of plaintiff's Complaint speaks for itself.

74. Deny the allegations set forth in paragraph 74 of plaintiff's Complaint.

75. Deny the allegations set forth in the first sentence of paragraph 64 in plaintiff's Complaint; state that there are over 550 federally recognized Native American tribal governments in the United States; and state that the phrase "official tribes" is unintelligible.

76. Deny the allegations set forth in paragraph 76 of plaintiff's Complaint.

77. Deny the allegations set forth in paragraph 77 of plaintiff's Complaint.

78. Deny the allegations set forth in paragraph 78 of plaintiff's Complaint.

79. State that the definition alleged in paragraph 79 of plaintiff's Complaint is unattributed and that the Native American Parties therefore can neither admit nor deny that the unattributed source has purported to offer the alleged definition; and deny the remaining allegations set forth in paragraph 79 of plaintiff's Complaint.

80. State that Section 2(a) does not itself use the word "offensive"; and state that the definitions alleged in paragraph 79 of plaintiff's Complaint are unattributed and that the Native American Parties therefore can neither admit nor deny that the unattributed source(s) has purported to offer the alleged definitions.

81. Deny the first and third sentences in paragraph 81 of plaintiff's Complaint; and state that they are without knowledge or information sufficient to form a belief as to the second sentence therein.

82. Deny the allegations set forth in paragraph 82 of plaintiff's Complaint.

83. Deny the allegations set forth in paragraph 83 of plaintiff's Complaint.

84. Deny the first and last sentences in paragraph 84 of plaintiff's Complaint; and state that the remaining allegations in that paragraph are too vague to permit the Native American Parties to admit or deny.

85. Deny the allegations set forth in paragraph 85 of plaintiff's Complaint.

86. State that Section 2(a) of the Lanham Act speaks for itself.

87. Deny the allegations set forth in paragraph 87 of plaintiff's Complaint.

88. State that the TTAB Order referenced in paragraph 88 of plaintiff's Complaint speaks for itself.

89. Deny the allegations set forth in paragraph 89 of plaintiff's Complaint.

90. Deny the allegations set forth in paragraph 90 of plaintiff's Complaint.

91. Deny the allegations set forth in paragraph 91 of plaintiff's Complaint.

92. State that the allegations set forth in paragraph 92 of plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

93. State that the allegations set forth in paragraph 93 of plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

94. State that Section 2(a) is an integral component of the Lanham Act; and state that the allegations set forth in paragraph 94 of plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny.

95. Deny the allegations set forth in paragraph 95 of plaintiff's Complaint.

96. Deny the allegations set forth in paragraph 96 of plaintiff's Complaint.

97. Deny the allegations set forth in paragraph 97 of plaintiff's Complaint.

98. Deny the allegations set forth in paragraph 98 of plaintiff's Complaint.

99. State that the TTAB Order referenced in paragraph 99 of plaintiff's Complaint speaks for itself, and otherwise deny the allegations set forth in paragraph 99 of plaintiff's Complaint.

100. Deny the allegations set forth in paragraph 100 of plaintiff's Complaint.

101. Deny the allegations set forth in paragraph 101 of plaintiff's Complaint.

102. Deny the allegations set forth in paragraph 102 of plaintiff's Complaint.

103. Deny the allegations set forth in paragraph 103 of plaintiff's Complaint.

104. Deny the allegations set forth in paragraph 104 of plaintiff's Complaint.

105. Admit that one of the challenged marks was registered in 1967; affirmatively allege that not all of the Native American Parties, and not all Native Americans, were alive and of legal age at the time of the first registration; affirmatively allege that the Washington Football Club has been on actual notice of the offensive, disparaging, contemptuous, and disreputable

character of the term *redskin(s)* since the time of the first registration; and affirmatively allege that the defense of laches is not available to the Washington Football Club.

106. State that the allegations set forth in the first sentence of paragraph 106 in plaintiff's Complaint are too vague to permit the Native American Parties to admit or deny; and deny the second sentence in that paragraph.

107. Deny the allegations set forth in paragraph 107 of plaintiff's Complaint.

Response to First Cause of Action

108. The Native American Parties incorporate herein their responses to paragraphs 1 through 107 of the Complaint.

109. Deny the allegations set forth in paragraph 109 of plaintiff's Complaint.

Response to Second Cause of Action

110. The Native American Parties incorporate herein their responses to paragraphs 1 through 107 of the Complaint.

111. Deny the allegations set forth in paragraph 111 of plaintiff's Complaint.

Response to Third Cause of Action

112. The Native American Parties incorporate herein their responses to paragraphs 1 through 107 of the Complaint.

113. Deny the allegations set forth in paragraph 113 of plaintiff's Complaint.

114. Deny the allegations set forth in paragraph 114 of plaintiff's Complaint.

115. Deny the allegations set forth in paragraph 115 of plaintiff's Complaint.

116. Deny the allegations set forth in paragraph 116 of plaintiff's Complaint.

Response to Fourth Cause of Action

117. The Native American Parties incorporate herein their responses to paragraphs 1 through 107 of the Complaint.

118. Deny the allegations set forth in paragraph 118 of plaintiff's Complaint.

Response to Fifth Cause of Action

119 The Native American Parties incorporate herein their responses to paragraphs 1 through 107 of the Complaint.

120. Deny the allegations set forth in paragraph 120 of plaintiff's Complaint.

121. Deny each and every allegation set forth in plaintiff's Complaint, except to the extent expressly admitted herein.

Affirmative Defenses

122. The Complaint fails, in whole or in part, to state a claim upon which relief may be granted.

123. The Washington Football Club had the opportunity to participate fully in the proceedings below over a period of six years and seven months, and accordingly it received due process.

124. The challenged service marks disparage Native Americans and hold Native Americans up to ridicule and contempt, and their registration is void *ab initio*.

125. Section 2(a) of the Lanham Act should be construed and applied consistent with the Indian Trust Doctrine.

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August 30, 1999

United States District Court
for the District of Columbia
Office of the Clerk
333 Constitution Avenue NW
Washington, D.C. 20001

Re: Pro Football, Inc. v. Harjo et al.
Court File No. 1: 99CV01385 United States District Court for the District of Columbia

Dear Marc:

Enclosed for filing is Defendants' Joint Answer to Complaint in this matter.

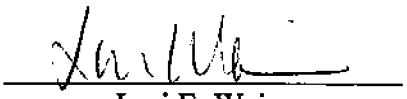
Very truly yours,

Michael A. Lindsay

MAL:skk
Enclosure

CERTIFICATE OF SERVICE

I certify that on the 26th day of September, 2006, I caused a true copy of Registrant's Motion to Suspend The Proceeding to be served on Petitioners' attorney, Philip J. Mause, Drinker Biddle & Reath LLP, 1500 K Street, N.W., Suite 1100, Washington, D.C. 20005-1209, via First Class mail.



Lori E. Weiss